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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,729	02/07/2002	Brian Patrick O'Hara		7195

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06/20/2003
Brian Patrick O'Hara
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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 06/20/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,729

Applicant(s)

O'HARA, BRIAN PATRICK

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the leather cover and the manner of how the device is secured on the hip must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because it is unclear from the drawings which reference characters have been used to designate the various parts. As best seen from the figures, it appears that the same numbers have been used to designate different parts and visa versa. Since applicant has failed to indicate what the different views of the drawings represent e.g. elevation, sectional view, etc. Additionally, the drawings are in contradiction to applicant's specification, because as best understood from the specification the instant invention is a L-shaped device having foam padding on both sides of the back portion (one leg of the L) and on the inner portion of the side portion (the other leg of the L) and a belt. However, when reviewing figures 2 and 3, this does not appear to be the case, the instant invention appears to be a parallelepiped having foam padding covering the entire exterior of the parallelepiped. Note: it is not possible to determine if it is the foam padding or the leather covering the exterior of the parallelepiped, since the leather covering has not been identified in the specification or drawings, therefore.

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3. The drawings are objected to under 37 CFR 1.83(a) because the figures fail to show the plastic siding, the back siding, the belt, the foam and the cover and the correct relation between the above parts as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

Arrangement of the Specification

4. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.

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- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In

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chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

(j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

(k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

It appears that applicant is somewhat familiar with the "Arrangement and Content of the Specification". The above information has been provided for applicant's use, so that the headings

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and contents under the headings can be correctly placed. Additionally, the above description is to aid applicant in better understanding what is required under each heading. For instance, under the heading "Description of the Drawing", applicant is required to give a brief description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74. What has been presently included under the aforementioned heading should be under the heading "Brief Description of the Invention", this is where the various parts should be described and identified with a reference number that corresponds to the various parts on the drawings. Note the format of the disclosure in the patent(s) cited.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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7. The disclosure is objected to because of the following informalities: on page 5, line 1, “to is” should be changed to --to a--; on page 7, line 6, “her hips” should be changed to --his/her hips--. Appropriate correction is required.

8. The disclosure is objected to because of the following informalities: see MPEP 608.01 “USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS”: In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications. The initials S.I. stand for “Le Système International d' Unités,” the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology. Appropriate correction is required for the above objection.

Claim Objections

9. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with “I (or We) claim”, e.g. “The invention claimed is” (or the equivalent). It is only necessary to include the above phrase at the top of the page before the claims. Additionally the claims should begin with a capital letter and end with a period. Periods may not be used elsewhere in the claims except for abbreviations. See MPEP 608.01(m).

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10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claims 1 and 2 “protruding arm” and in claim 2, “enabling right- and left-handers to use the pitching tutor”.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the pitching tutor forming a L-shaped siding and backing, wherein the pitching tutor is used to release the ball at the hip, to have accurate wrist snap and to control the

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bending of the arm, does not reasonably provide enablement for a protruding arm (plastic siding) which protrudes away from the body to provide a blocking point for the pitcher (it is unclear how the plastic siding without the aid of the plastic backing and the belt is able to accomplish the above step, since such has not been disclosed or shown; enables right- and left-handers to use the pitching tutor (it is not clear how the device is used for both right- and left-handed users, since such was not disclosed or shown). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. As best understood from the specification and drawings the "pitching tutor" is a combination of the plastic siding and the plastic backing, and not just one or the other. Therefore, it is not readily apparent from the specification and drawings, that applicant were in possession of the claimed invention at the time of filing. Therefore, it is not understood nor is it readily apparent, how the desired steps as recited in the claims and pages 6 and 7 of the specification are accomplished when attaching just the "plastic siding" to the hip of the pitcher? It is also not readily apparent or sufficiently disclosed how the "pitching tutor" as claimed can be made and used in order to achieve the a straight arm, indicate the proper "release point" and achieve a correct wrist snap? Note: Because the claims are so informal it is unclear what is being claimed.

15. Claims 1-5 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner

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as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. A few representative examples are noted as follows:

Claim 1 recites the limitation "the protruding arm" in line 1; "the body" in line 2; "the pitcher's forearm" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the unique design" in line 1; "the protruding arm" in line 1; "the Pitching Tutor" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the design of" in line 1; "the Pitching Tutor" in line 1; "The "L" shaped backing and siding" in line 2; "The manner of how the device" in line 3; "the hip" in line 3. There is insufficient antecedent basis for this limitation in the claim. Note: It does not appear that "the hip" is accurate as disclosed.

Claim 4 recites the limitation "the structure" in line 1; "the Pitching Tutor" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the purpose" in line 1; "the Pitching Tutor" in line 1; "the ball" in line 2; "the hip" in line 2; "the bending of the arm" in line 3. There is insufficient antecedent basis for this limitation in the claim.

NOTE: Because the claims are so informal the following prior art references are necessitated.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Brunty (5,403,002).

Regarding claim 1, Brunty discloses a protruding arm or plastic siding (10) which protrudes away from the body (see figure 1) to provide a blocking point for the pitcher's forearm (see column 1, lines 34-41; and column 4, lines 29-34). Regarding the intended use limitation "the Pitcher's forearm". The recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, Brunty discloses a unique design of the protruding arm or plastic siding (10) which enables right- and left-handers to use the device (see figure 1). The device of Brunty can be conveniently repositioned on either side of the user so either a right- or left-handed user is able to utilize it.

Regarding claim 4, Brunty discloses a training device (10) that enables durability. Brunty's device can be made of either a relatively stiff plastic material or a less rigid plastic such

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as polyethylene etc. (see column 4, lines 29-34), and it is also provided with cushioning. Note: all devices are made under the assumption that they will be durable and sturdy.

18. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Socci (4,984,789).

Regarding claim 5, as best claim 5 is understood, Socci discloses a training device that is used to tutor or train proper throwing or pitching, wherein the user will be taught to release the ball at the proper time and position (see column 2, lines 63-68 and column 3, lines 5-13), accurate wrist which maximizes the velocity of the pitched ball (see column 1, lines 32-36); and controlling the bending movement of the arm (see column 1, lines 44-47).

Additionally:

19. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Todaro (5,390,929).

Regarding claim 1, Todaro discloses a protruding arm or plastic siding (18) which protrudes away from the body (see figures 1 and 7) to provide a blocking point for the player's forearm (see column 1, lines 34-41; and column 4, lines 29-34).

Regarding claim 2, Todaro discloses a unique design of the protruding arm or plastic siding (18) which enables the device to be used both on the right- and left-hand of the user, therefore, being able to accommodate various types of shots and various needs of the user, namely being left- or right-handed. (See figures 7 and 12).

Regarding claim 3, Todaro discloses a design of the apparatus (see figure 1) which shows an "L" shaped backing (22) and siding (24) and a manner of securing the belt (14) around the

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waist in order for the apparatus to be partially covering the hip area (see figures 7 and 8; also see column 1, lines 60-68).

Regarding claim 4, Todaro discloses a training device (10) that enables durability since it is made of lightweight deformable material, which yields upon impact, therefore, insuring longevity of the device.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

20. Claim 3 rejected under 35 U.S.C. 102(a and e) as being anticipated by Halfacre (6,428,421).

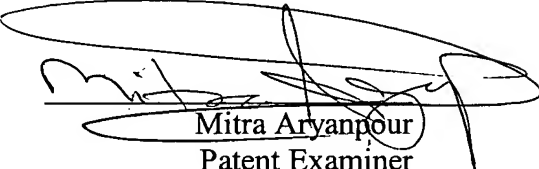
Regarding claim 3, as best claim 3 is understood, Halfacre discloses the design of the training aid (see figure 1) which aids in the hands and hip rotation and movement during use, comprising a L-shaped backing (40) and siding (50a or 50b); attachment means (20 and 30) for attaching the device to the upper leg of the user which is in the hip area (see figure 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Mitra Aryanpour
Patent Examiner
12 June 2003